REMARKS

In the pending Office Action, the Examiner rejected claims 1-7, 22, 29, 31-33, and 35 under 35 U.S.C. § 103(a) as unpatentable over *Schneier et al*, U.S. Patent No. 5,871,398 ("*Schneier*"), in view of *Yacenda*, U.S. Patent Application Publication No. 2001/0003100 ("*Yacenda*"), and *Strachan*, U.S. Patent No. 6,347,086 ("*Strachan*").

By this Amendment, Applicants have amended claim 35 and added new claim 37. Claims 1-7, 22, 29, 31-33, 35, and 37 are currently pending.

Applicants respectfully traverse the rejection of claims 1-7, 22, 29, 31-33, and 35 under 35 U.S.C. §103 as being obvious from *Schneier* in view of *Yacenda* and *Strachan*. A *prima facie* case of obviousness has not been established.

To establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a), each of three requirements must be met. First the reference or references, taken alone or combined, must teach or suggest each and every element recited in the claims. M.P.E.P. § 2143.03 (8th ed. 2001, 3rd revision Oct. 2005). Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the references in a manner resulting in the claimed invention. Id. at § 2143.01. Third, a reasonable expectation of success must exist that the proposed modification will work for the intended purpose. Id. at § 2143.02. Moreover, each of these requirements must "be found in the prior art, and not be based on applicant's disclosure." Id. at § 2143.

A *prima facie* case of obviousness has not been made at least because the Examiner has not shown any suggestion or motivation, either in the references

themselves or in the knowledge generally available to one of ordinary skill in the art, to

modify *Schneier* and *Yacenda* with *Strachan* in an attempt to produce the claimed

invention.

The M.P.E.P. states:

Obviousness can only be established by combining or modifying the

teaching of the prior art to produce the claimed invention where there is

some teaching, suggestion, or motivation to do so found either explicitly or

implicitly in the references themselves or in the knowledge generally

available to one of ordinary skill in the art. . . . [I]t is necessary to

ascertain whether or not the reference teaching would appear to be

sufficient for one of ordinary skill in the relevant art having the reference

before him to make the proposed substitution, combination, or other

modification.

M.P.E.P. § 2143.01 (emphasis added) (internal citations omitted).

First, Applicants submit that *Schneier*, *Yacenda*, and *Strachan* do not provide the

requisite motivation to one of ordinary skill in the art to facilitate their combination, from

within the references themselves. Applicants also note that one of ordinary skill in the

art must have this motivation or reason *without the benefit of Applicants' specification* to

modify the references. M.P.E.P. § 2142.

Schneier describes an "off-line remote lottery system which enables players to

purchase instant-type lottery game outcomes from a randomized prize data stream in a

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central computer, and view the outcomes on remotely disposed gaming computers." (*Schneier*, Abstract). *Yacenda* describes a "remotely accessed lottery system" that uses "tickets . . . [which] are digitally rendered . . . and have outcomes predetermined." (*Yacenda*, Abstract). *Strachan*, on the other hand, discusses "pick pools on sports events" where a number of users "compete against one another, with 'winners' being those who make the most correct suggestions regarding . . . sporting events." (*Strachan*, Abstract).

Making "picks on pro or college football" and viewing "the results of [a] pool . . . e.g., after each week's Monday night NFL game," as discussed in *Strachan*, does not lend itself to combination with purchasing tickets for instant-type lottery games (*Schneier* and *Yacenda*). Both *Schneier* and *Yacenda* describe systems that predetermine results of no-skill lottery games. In the system of *Strachan*, in contrast, players win or lose based on picking a certain number of correct outcomes of sporting events, such as football games. Clearly, it would be impossible to predetermine outcomes in the system of *Strachan*, further highlighting the disparities between the references.

Applicants therefore submit that one of ordinary skill in the art would not have been motivated to combine *Strachan*'s system of pick pools for sporting events with *Schneier* and *Yacenda's* system of instant lottery tickets.

Furthermore, Applicants dispute the Examiner's allegations that "[i]t would have been obvious to a person of ordinary skill in the art . . . to send the results of the game to a second terminal in the game of Schneier as taught by Strachan in order to allow the

player to monitor his current account's balance and to allow other players to view the game processed." (Office Action, p. 3). *Schneir's* system cannot be modified as suggested by the Examiner for at least the reason that *Strachan's* system of picking outcomes from sports games renders it completely unnecessary to have outcomes generated from a randomized prize data stream. Indeed, *Strachan* teaches away from outcomes generated from a randomized prize data stream at least for the reason that "picks pertaining to games that have already started will not be accepted/validated." (*Strachan*, col. 4, ll. 38-41). Similarly, *Yacenda's* system cannot be modified as suggested by the Examiner for at least the reason that *Strachan's* system renders it impossible to have outcomes predetermined. (*See Strachan,* Fig. 2, col. 8 ll. 27-39).

Still further, "[t]he initial burden is on the Examiner to provide some suggestion of the desirability of doing what the inventor has done." M.P.E.P. § 2142. The prior art references themselves must provide the motivation to combine, and the presently applied references fail to do so. Although the Examiner has alleged that the combination of *Schneier* and *Strachan* would "allow the player to monitor his current account's balance and to allow other players to view the game processed," one skilled in the art would have no way to send the predetermined results of *Schneier* to a second terminal during game play because the gaming computer of *Schneier* is not physically or electronically connected to a central network during game play. (*Schneier,* col. 1, ll. 20-26). Furthermore, there would be no need for "other players to view the game processed" in *Schneier,* i.e., an instant lottery game with predetermined results.

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The Examiner's attempt to combine *Schneier*, *Yacenda*, and *Strachan* fails because a *prima facie* case of obviousness has not been made. Therefore, the rejections of claims 1, 22, 29, 31, 33, and 35, and dependent claims 2-6 and 32 under 35 U.S.C. §103 as being obvious from *Schneier* and *Yacenda*, and further in view of *Strachan* should be withdrawn.

Furthermore, the Examiner has failed to show a teaching or suggestion of every element of several claims, and therefore a *prima facie* case of obviousness has not been established.

For example, claim 3 calls for a combination including "wherein receiving, at the server, a purchase request includes receiving a purchase amount and a denomination value." The Examiner cited *Schneier* as teaching "a purchase amount of 'm' tickets and a denomination value represented through different price points." (*Office Action*, p. 3). Applicants respectfully disagree with the Examiner's reading of *Schneier*. *Schneier* teaches that "a 'ticket' as used herein means a single net outcome or payoff." (*Schneier*, col. 6, ll. 7-8). Accordingly, *Schneier*'s teaching of "m" tickets and price points is not a teaching of "receiving, at the server, a purchase request includes receiving a purchase amount and a denomination value," as recited in claim 3.

Claim 4 calls for a combination including, for example, "wherein receiving, at the server, a purchase request includes receiving a number of wagers and a denomination value." The Examiner cited *Schneier* as a teaching of "a denomination value represented through different price points." (*Office Action*, p. 3). The Examiner cited *Schneier* as a teaching of "a purchase amount of 'm' tickets and a denomination value

represented through different price points." (*Office Action*, p. 3). However, *Schneier* teaches "a 'ticket' as used herein means a single net outcome or payoff." (*Schneier*, col. 6, ll. 7-8). Accordingly, *Schneier's* teaching of "m" tickets and price points is not a teaching of "receiving, at the server, a purchase request includes receiving a number of wagers and a denomination value," as recited in claim 4.

Therefore, the rejection of dependent claims 3-4 under 35 U.S.C. §103 as being obvious from *Schneier* and *Yacenda*, and further in view of *Strachan*, is thus improper and should be withdrawn.

Still further, amended claim 35 calls for a combination including, for example, "determining, at the server, results of the at least one wager before the game play has begun and after receiving the purchase request." Neither *Schneier*, *Yacenda*, nor *Strachan*, nor their combination, teaches or suggests "determining, at the server, results of the at least one wager before the game play has begun and after receiving the purchase request," as recited in amended claim 35. Instead, *Schneier* teaches that outcomes are either predetermined or "generated 'on the fly' (i.e., contemporaneous with or simultaneous to a purchase request." (*Schneier*, col. 9, ll. 42-50). *Yacenda* fails to cure *Schneier's* deficiencies, and instead teaches "outcomes predetermined at the central station prior to the request for purchase." (*Yacenda*, Abstract). *Strachan* also fails to teach or suggest "determining, at the server, results of the at least one wager before the game play has begun and after receiving the purchase request," as recited in amended claim 35.

Finally, new claim 37 calls for a combination including, for example, "calculating a wager pool based on the results; while the wager pool is greater than zero, determining results of additional wagers, and updating the results of the wagers based on the results of the additional wagers; and updating a player account based on the results before game play has begun." Neither *Schneier*, *Yacenda*, nor *Strachan*, nor their combination, teaches or suggests "calculating a wager pool based on the results; while the wager pool is greater than zero, determining results of additional wagers, and updating the results of the wagers based on the results of the additional wagers; and updating a player account based on the results before game play has begun," as recited in new claim 37.

In view of the foregoing remarks, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims. The preceding arguments are based only on the arguments in the most recent Office Action, and therefore do not address patentable aspects of the invention that were not addressed by the Examiner in the Office Action. The claims may include other elements that are not shown, taught, or suggested by the cited art. Accordingly, the preceding argument in favor of patentability is advanced without prejudice to other bases of patentability.

Furthermore, the Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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